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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/433,135	11/03/1999	JOHN G. SAVAGE	8243.00	2108

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MICHAEL CHAN
NCR CORPORATION
1700 SOUTH PATTERSON BLVD
DAYTON, OH 45479-0001

EXAMINER	
RUHL, DENNIS WILLIAM	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/433,135	SAVAGE ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *43-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *43-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's amendment of 7/12/04 has been received and entered. Currently claims 43-52 are pending. The examiner will address applicant's remarks at the end of this office action.

1. The amendment filed 7/12/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The language of claims 43,46,48,50,51,52, that states "without the user having to train the terminal to recognize the spoken words". This is new matter that was not disclosed in the application as originally filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 43-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The language of claims 43,46,48,50,51,52, that states "without the user having to train the terminal to recognize the spoken words" is considered to be new matter. This is new matter because it was not disclosed in the application as originally filed. The

specification never disclosed anything about not having to train the terminal or not having to train the terminal so this is new matter and must be canceled from the claims.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 43,44,46-49, are rejected under 35 U.S.C. 102(e) as being anticipated by Rabin (6081782).

For claims 43,44,46,47,48,49, Rabin discloses a self-service terminal that allows the user to conduct a transaction verbally (spoken words). Rabin discloses a means to create an audible prompt (processor 201), means to deliver the prompt (203 and/or 104), spoken word receiving means (microphone 103), and means to compare the received spoken word (201 and/or 311). See column 3, line 15 for the dispensing means. When a user wishes to interact with the terminal, this fact is sensed. This could simply be the pushing of a button on the terminal or the speaking of a word. See

column 7, lines 40-45 where Rabin discloses "displayed to the user". This indicates a display is present and this is a means to provide the customer with a number representing the balance of an account.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabin (6081782) in view of Paganini et al. (4420751).

Rabin discloses the invention substantially as claimed. Rabin does not disclose a proximity sensor as claimed. Paganini discloses an ATM that has a location determining means for determining when a customer is present at the ATM for numerous reasons. See column 1, line 50 to column 2, line 20 for the disclosed

reasons. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Rabin with a proximity sensor as disclosed by Paganini so that the problems with ATM machines disclosed by Paganini in column 1 to column 2 can be avoided.

8. Claims 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabin (6081782)

For claims 50,52, Rabin does not disclose that the spoken prompt from the terminal is the same word that is spoken by the user to cause an action to be done. Rabin discloses that the terminal gives out verbal instructions and takes in verbal commands from the users. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the terminal of Rabin with the ability to "help" the customer with their transaction by informing them of their possible choices. For example, if a customer is just standing there and has not indicated an action to be done, the terminal can instruct them on possible choices (i.e. for withdrawal say "withdrawal", for a balance inquiry say "check balance", etc.). Having the terminal "help" the customer by informing them of their possible transaction options is considered obvious.

For claim 51, Rabin does not disclose that the spoken prompt from the terminal is a question with either a positive or negative response. Rabin discloses that the terminal gives out verbal instructions and takes in verbal commands from the users. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the terminal of Rabin with the ability to "help" the customer with their

transaction by asking them what they want to do. This could also be asking them if they would like to perform another transaction after one has just been completed. It is very old and well known that one question that is asked by ATM machines is "Would you like to perform another transaction". Having a terminal ask this question is considered obvious.

9. Applicant's arguments filed 7/12/04 have been fully considered but they are not persuasive. The arguments don't amount to anything more than a repeating of what limitations are claimed in the pending claims. There is no discussion of the closest prior art (Rabin, Paganini) and why the prior art does not disclose what is claimed. The arguments are taken as mere allegations of patentability. The arguments are found non-persuasive.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DENNIS RUHL
PRIMARY EXAMINER